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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,909	02/24/2004	Nadia Gardel	05725.1339-00	6147

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EXAMINER	
SOROUSH, ALI	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
06/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,909	GARDEL ET AL.	
	Examiner	Art Unit	
	ALI SOROUSH	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *80-83,86-93,97-100 and 104-186* is/are pending in the application.

4a) Of the above claim(s) *81,83 and 150-166* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *80,82,86-93,97-100,104-149 and 167-186* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02232009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement of Receipt

Applicant's response filed on 02/23/2009 to the Office Action mailed on 08/22/2008 is acknowledged.

Status of the Claims

Claims 1-79, 84, 85, 94-96, and 101-103 are cancelled, claims 81, 83, and 150-166 are withdrawn, and claims 80-83, 86-90, 92, 97-100, 104-111, 114-117, 141, and 181 are currently amended. Therefore, claim 80, 82, 86-93, 97-100, 104-149, and 167-186 are currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80, 82, 84-149 and 167-186 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of U.S. Patent No. 10/603,698. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a water-in-oil foundation comprising at least one oil, an aqueous phase, a copolyol and a coloring material. The difference between the instant invention and the copending application is the weight percentages and concentrations of the components. This determination would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing of unexpected results attributable to the specific concentrations of the components employed by applicant in the instant case.

Response to Arguments

Applicants request that the examiner holds the rejection in abeyance until there is an indication of allowable subject matter. The examiner can grant this request, the double patenting rejection is maintained and a terminal disclaimer is require to overcome the rejection.

New Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 80, 82, 86-93, 97-100, 104-149, and 167-186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US Patent 5843417, Published 12/01/1998) in view of Nicoll et al. (US Patent 5196187, Published 03/23/1993).

Applicant Claims

Applicant claims a water-in-oil foundation comprising at least one oil, an aqueous phase containing water and at least a water-miscible polyol and a dyestuff.

Determination of the scope and content of the prior art
(MPEP §2141.01)

Hanna et al. disclose a water-in-oil emulsion make up composition comprising 5% coated iron oxide particles, 8% coated titanium oxide particles, 22% isododecane, 4% propylene glycol, and water qs to 100%. (See column 7, example). The makeup composition comprises moisturizers such as propylene glycol which can be present in amounts including 0.1-10%. (See column 6, Lines 25-32). The composition can further comprise water-soluble or water-dispersible polymers such as polymethylmethacrylate in amounts of 0.1 to 10%. (See column 5, Lines 34-46). The composition can also further include volatile silicone oils in order to achieve a desired feel and behavior of the composition. (See column 3, Lines 33-43).

Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)

Hanna et al. do not teach the specific volatile silicone oils as claimed by applicant. This deficiency is cured by the teachings of Nicoll et al.

Nicoll et al. a cosmetic composition suitable for topical application comprising a 5 to 20% volatile polydimethylsiloxane such as Dow Corning 345 fluid (decamethylcyclopentasiloxane/dodecamethylcyclohexasiloxane). (See abstract and Column 4, Lines 29-41).

Finding of prima facie obviousness
***Rational and Motivation* (MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Hanna et al. with Nicoll et al. One would have been motivated to do so in order to adjust the feel and behavior of the cosmetic composition on the skin it is being applied to. One would have expected success since Hanna et al. and Nicoll et al. teach oil-in-water cosmetic composition for topical application. For the foregoing reasons the instant claims would have been obvious at the time of the instant invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616